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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/419,592 | 10/18/1999 | MICHAEL J. LANDS | 2176 | 1475 |

7590

02/09/2004

PATENT COUNSEL
UNITED STATES SURGICAL, TYCO HEALTHCARE GROUP LP
150 GLOVER AVENUE
NORWALK, CT 06856

EXAMINER

ROBERT, EDUARDO C

ART UNIT PAPER NUMBER

3732

DATE MAILED: 02/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/419,592

Applicant(s)

LANDS ET AL.

Examiner

Eduardo C. Robert

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 5, 6, 8-10, 16, 17 and 19-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7, 11-15 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 October 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Species I, i.e. Figures 1-9 and 14, in Paper No. 10 is acknowledged.

It is acknowledged that applicants believe claims 1-4, 7-15, and 18-21 read on the elected Species. It is noted that comparison of the claims with Figures 1-9 and 14 and the specification shows, however, that the Species elected does not have a coat of a non-stick coating on an inner facing surface of each of the jaw members as required in claims 8 and 19. Moreover, it appears that claims 8 and 19 are directed to the non-elected Species IV (Figures 15-17) which is disclosed as having the coating. Furthermore, the elected Species does not have non-conductive portion, as required in claims 9 and 20, or a semi-conductive portion, as required in claims 10 and 21. These claims 9, 10, 20, and 21 appear to be directed to the non-elected Species IV (Figures 15-17) which is disclosed as having these structural characteristics.

Claims 1 and 11 are generic claims.

Claims 5, 6, 8-10, 16, 17, and 19-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 10.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the embodiment wherein the

Art Unit: 3732

manipulating portions of each of the jaw members are filleted, as per claims 7 and 18 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Applicant is required to submit a proposed drawing correction in response to this Office Action. Any proposal by the applicant for amendment of the drawings to cure defects must consist of two parts:

- a) A separate letter to the Draftsman in accordance with MPEP § 608.02(r); and
- b) A print or pen-and-ink sketch showing changes in red ink in accordance with MPEP § 608.02(v).

IMPORTANT NOTE: The filing of new formal drawings to correct the noted defect may be deferred until the application is allowed by the examiner, but the print or pen-and-ink sketch with proposed corrections shown in red ink is required in response to this Office Action, and may not be deferred.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Walter (U.S. Patent 2,397,823).

Walter discloses a forceps comprising first and second jaw members 39, 38 operatively attached and adjacent a distal end of the forceps. The forceps also having a handle assembly adjacent a proximal end of the forceps (see Figure 1). The jaw members 38, 39 are movable between an open position and a closed position. The jaw member 38 and 39 have inner facing

Art Unit: 3732

surfaces, each having a plurality of different waveforms (see Figures 1, 3, 5, 6, and page 2, lines 25-40). Each jaw member includes two portions one that can be considered or named a clamping portion and the other a manipulating portion, i.e. at the distal end of the jaw. The plurality of waveforms of the jaw members are longitudinally disposed on the inner facing surface (see Figure 3 for example). The manipulating portion or distal end of the jaw is filleted.

Claims 1-4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Rose (U.S. Patent 5,275,615 cited on IDS by applicants).

Rose discloses a forceps having first and second jaw members 21, 22 operatively attached and adjacent a distal end of the forceps. The forceps further having a handle assembly adjacent a proximal end of the forceps (see Figure 1). The jaw members are movable between an open position and a closed position. Each jaw member having an inner facing surface with a plurality of different waveforms, i.e. the waveform 60 and 61 and the waveform formed by the serrations shown, for example, in Figures 2 and 3. Each jaw member includes two portions one that can be considered or named a clamping portion and the other a manipulating portion, i.e. at the distal end of the jaw. The clamping member is wider than the manipulating portion (see Figure 4). The waveforms are longitudinally disposed. The distal end of the jaw can be considered filleted.

Claims 11-15 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Springer (U.S. Patent 3,404,677 cited on IDS by applicants).

Springer discloses a forceps comprising a shaft portion 18 having proximal and distal ends; first and second jaw members 22, 23 pivotally attached to the distal end of the shaft by a pivot assembly (see Figure 6), each of the jaw members comprising an opposing inner facing surface having a plurality of waveforms 24 and 25. The waveforms are complementary to each

Art Unit: 3732

other. The inner facing surface of at least one of the jaw members includes at least one fenestrated portion, e.g. 26 or 27. The forceps also includes a handle portion attached to the proximal end of the shaft, wherein the handle portion has an activator assembly for opening and closing the jaw members. The fenestrated portions 26 and 27 are vertically aligned. The jaw members includes two portions which could be named clamping portions and manipulating portions, i.e. at the distal end of the jaw. The waveforms are longitudinally disposed on the inner facing surface of each jaw member. The distal end of the jaw members appear to be filleted.

Conclusion

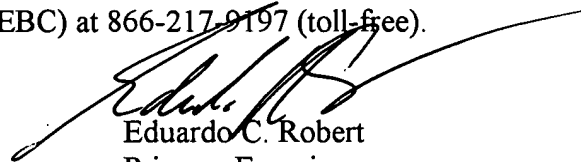
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for art cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 703-305-7333. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 703-308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3732

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eduardo C. Robert
Primary Examiner
Art Unit 3732

E.C.R.